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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: WILLIAM ALLOCCA *et al.*
APPLICATION No.: 09/547,540
FILED: APRIL 12, 2000
FOR: **PLACING A PURCHASE ORDER USING
ONE OF MULTIPLE PROCUREMENT
OPTIONS**

EXAMINER: YOGESH C. GARG
ART UNIT: 3625
CONF. No: 5837

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Sir:

I. REAL PARTY IN INTEREST

The rights of the inventors in this application have been assigned to Amazon.com, Inc.

II. RELATED APPEALS AND INTERFERENCES

Appellants' legal representative and the real party in interest are unaware of any appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the present appeal.

III. STATUS OF CLAIMS

Claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 are pending in the application.¹ Claims 11-12, 28, 34, 39, 42-49, 66 and 69-128 were canceled during prosecution, and claim 129 was added during prosecution. In addition, at the request of a Patent & Trademark

¹ The Appendix to this brief contains a copy of the claims on appeal.

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Office Examiner, claims that were originally numbered 29-129 at filing were subsequently renumbered as 28-128, respectively, in a Preliminary Amendment filed on April 10, 2001, due to the inadvertent omission of a claim numbered 28 in the claims as originally filed. Unless otherwise noted, references to claims in this document will use claim numbers that reflect the renumbering of those claims.

The Examiner has rejected claims 1-8 and 52 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; has rejected claims 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-51, 53-65, 67-68 and 129 under 35 U.S.C. § 103(a) as being unpatentable over Hartman (U.S. Patent No. 5,960,411) in view of Yamada (U.S. Patent No. 6,336,100 B1);² has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Hartman and Yamada in view of an Official Notice of obviousness; and has rejected claims 14 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Hartman and Yamada in view of Holland (U.S. Patent No. 6,493,742).

Appellants appeal the rejection of each of the pending claims.

IV. STATUS OF AMENDMENTS

Appellants have not filed any amendment subsequent to the final rejection.

V. SUMMARY OF DISCLOSURE

Appellants' invention is directed to techniques for assisting users of client computing systems to purchase items in a secure and efficient manner from remote server computing systems over a network (*e.g.*, the Internet). In particular, Appellants' inventive techniques provide users with the ability to predefine numerous distinct groups of item ordering information (referred to as "procurement options"), and to then use their predefined procurement options as alternatives for purchasing items. (Appellants' patent application, 25:3-18, 6:14-18.)

² While the Examiner's initial enumeration in the prior Office Action of the claims that were rejected based on the combination of Hartman and Yamada also included claims 1-7 and 52, the Examiner did not specifically apply these prior art references to the claim elements of claims 1-7 and 52, and immediately afterward clarified that "rejection of claims 1-7 and 52 is being done in the light of 35 U.S.C. 112, first paragraph rejection made above", as well as that "[s]ince the newly added limitations in claims 1-8 and 52 constitute new matter they are not being further treated on merits for prior art rejection." (Examiner's Action dated July 8, 2003, 9:3-7 and 8:17-18).

Each predefined procurement option has associated information of multiple types, such as a specified delivery address, a specified payment source (*e.g.*, credit card information), and specified shipping instructions (*e.g.*, Next-Day Air shipping versus standard ground shipping). In this way, each user can have multiple procurement options that correspond to different groups of order fulfillment information, such as to different delivery addresses (*e.g.*, addresses for home and work), different payment sources (*e.g.*, a personal credit card, a corporate credit card, and a predefined corporate account), and/or different shipping instructions. In addition, each user can further define procurement options for use with gifts to others, such as to include delivery information for the gift recipient and payment information for the user. Moreover, procurement options may in some embodiments include additional types of information related to item ordering, such as wrapping instructions (*e.g.*, for items given as a gift). In some embodiments, each procurement option for a user has a unique combination of order fulfillment information. (*Id.* at 25:3-18, 28:24-29:2, 29:13-24, 33:4-11, 49:8-50:5 and elements 3210-3280 of Figures 32A-32B.)

When information related to a potential item of interest is displayed to a user, indicators for each of the multiple procurement options predefined for the user can also be displayed, enabling the user to initiate an order for the item by selecting one of multiple displayed indicators. After such procurement option selection, the client system sends a request to the server system to order the item using the information associated with the selected procurement option. After receiving such an item order, the server system uses the associated information for that procurement option to cause the item order to be fulfilled, such as by shipping the item to the specified delivery address using the specified shipping instructions and by collecting payment for the order from the specified payment source. (*Id.* at 25:27-30:23.)

In contrast, the Background section of Appellants' patent application describes the typical prior art technique for purchasing items over the Internet, which involved the use of an online "shopping cart" model. With such a model, when a user selects an item being offered by a server computing system, the server metaphorically adds that item to a virtual shopping cart for the user. When the user is done selecting items, then the user purchases the items by providing billing and shipment information to order all the items in the shopping cart. While this shopping cart model provides some benefits, one problem that results from its use is that it requires many interactions

by the user, such as to initially select the one or more items to be added to the shopping cart, to indicate that item selection is complete, and to provide the various purchaser-specific order information (*e.g.*, the purchaser's name, the purchaser's credit card number, and a delivery address for the order) that is needed to complete the order. If a user is ordering only one item, then the overhead of confirming the various steps of the ordering process and providing the purchaser-specific order information is particularly cumbersome, and can be much more than the overhead of selecting the item itself. Also, with such an ordering model, each time an order is placed, sensitive information is transmitted over the Internet and subject to interception by unscrupulous third parties, such as the delivery address for the recipient of the item and the purchaser's financial information. (*Id.* at 3:7-28 and 2:11-3:6.)

The techniques described in Appellants' patent application address both security problems and inefficiency problems of prior art techniques for purchasing items. For example, by displaying indications to users that represent their predefined procurement options, users can easily select the appropriate combination of order fulfillment information to be used for an order, whether ordering items for themselves or as gifts for others. In addition, in some embodiments the selection or indication of one of the predefined procurement options by a user is sufficient to complete the item purchase without further action by the user, which provides even greater efficiency. Moreover, the use of predefined procurement options for item ordering allows secure ordering of items in addition to the efficiency benefits. In particular, in some embodiments the server system stores the various information associated with each of the defined procurement options, and thus the client system need send only an indication of a user-selected procurement option to the server system for the server system – the server system can then use the stored information for that procurement option to purchase an item, and thus sensitive information (*e.g.*, the delivery address of the item recipient and the payment information for the purchaser) is not transmitted between the client and server systems over the network. (*Id.* at 46:26-47:29, elements 3103 of Figures 31A and 31B, element 2005 of Figure 20B, 26:16-27:21, 34:17-27, 34:10-12 and 25:3-18.)

In addition to displaying indications of multiple predefined procurement options to a user to assist the user in purchasing an item, additional inventive techniques described in Appellants' patent application provide further benefits to users. For example, in some embodiments the user is also provided with one or more displayed indications that represent an ability of the user to

interactively create a new procurement option that will not only be used to purchase the item, but can also be used along with the other predefined procurement options when later purchasing other items. In particular, after selecting to create such a new procurement option for an item being purchased, the user is prompted to provide various information for the new procurement option being defined, and that new procurement option is then used to purchase the item. Another of the additional inventive techniques used in some embodiments includes designating one of the predefined procurement options for a user as a default procurement option, such that the user can order items with a single action by indicating to use the default procurement option, thus allowing even greater ordering efficiency for such orders, while at the same time allowing the user to easily select from other of the non-default procurement options when so desired. (*Id.* at 34:28-35:15, 30:28-33:18, element 3103g of Figure 31B, elements 2014 and 2016 of Figure 20B, all illustrated elements of Figures 31D and 21B-22, 25:17-26, 46:6-20, 28:17-23, and 27:3-12.)

VI. SUMMARY OF PRIOR ART REFERENCES

A. The Hartman Reference

The Hartman reference relates generally to techniques for a user to order items in a client/server computing environment using credit card information and a delivery address (referred to by Hartman as a “shipping address”) that was previously provided by the user and stored by the server. In some embodiments, the ordering of an item using the previously provided information can be performed by the user with a single action that selects a displayed control. (Hartman, Abstract and 3:31-4:46.)

The Examiner has conceded that “Hartman did not disclose displaying multiple groups/procurement options having information related to ordering the identified item” and that “Hartman . . . does not disclose displaying an indication selecting a default groups [sic, group] out of the identified multiple groups.” (Examiner’s Action dated July 8, 2003, 3:2-3 and 11:1-2.)

B. The Yamada Reference

The Yamada reference is directed to an online shopping system that allows a user to predefine multiple delivery addresses, such as a home address, a work address, and an address of a convenience store near to the user. After the user has indicated to purchase one or more items,

a screen analogous to a shopping cart ordering screen (referred to by Yamada as a “shopping list” of one or more items) is displayed to the user, and the user is prompted to specify the delivery address for the purchase by displaying the predefined delivery addresses to the user on that shopping list screen. In addition, the user can send an item to another recipient as a gift by interactively specifying a delivery address for that other recipient at the time of item purchase, but cannot predefine any such gift-related addresses. (Yamada, 1:18-22, 4:50-5:13, 2:66-3:12 and Figure 9.)

Yamada does not discuss predefining or using any information other than a delivery address when purchasing an item, such as payment information or shipping instructions. Yamada also is unrelated to single-action ordering of items, or more generally to specifying a delivery address for an item being purchased at any time other than after the item purchase instruction has been made by the user.

C. The Holland Reference

The Holland reference is related to the use of a wedding registry on the Internet, and notes that purchasers can have gifts wrapped. (Holland, Abstract and 1:25-46.)

The Examiner has relied on Holland only to disclose the existence of gift wrapping for ordered items, and Holland does not appear to be otherwise related to the use of multiple predefined procurement options for purchasing items in the manner described and claimed by Appellants.

D. The Gatto Reference

The Gatto reference is related to use of an Electronic Fund Transfer system, such as an automated teller machine (“ATM”), and in particular to allowing a user of such an ATM to define types of transactions (*e.g.*, withdrawals, deposits, transfers, etc.) that will later be presented to the user as choices. (Gatto, Abstract and 1:20-3:31.)

While the Examiner has not relied upon the Gatto reference to reject any of the pending claims, the Examiner did assert that “Gatto’s teachings are clearly analogous to the problems and the solutions disclosed in the instant application relating to the claimed limitations of displaying multiple procurement/order fulfillment options representing various unique combinations of delivery information and payment information – which correspond to multiple transactions display

in Gatto . . . Gatto's teachings make such claimed limitations of the present application obvious." (Examiner's Action dated July 8, 2003, 12:9-13:3.)

However, despite the Examiner's assertions regarding Gatto, the reference appears to be completely unrelated to ordering items or to defining any "procurement options" that include information other than electronic funds transfer information.

VII. ISSUES

The following issues are presented for review:

- A. Has the Examiner failed to establish a *prima facie* case of obviousness because none of the cited references, either alone or in combination, teaches or suggests using a computing system to assist a user in ordering an item using one of multiple predefined procurement options in the manner recited, with each procurement option having associated information of multiple types for use in ordering the item that includes at least payment information and delivery information?
- B. Assuming, *arguendo*, that a combination of the cited references did suggest that multiple predefined procurement options each having item ordering information of multiple types could be used to assist a user in ordering an item in the manner recited, has the Examiner failed to establish a *prima facie* case of obviousness because none of the cited references teaches or suggests each of several additional recited claim elements, including the following:
 - that the procurement option selected to order the item further includes "shipping instructions" along with the payment and delivery information such that the ordering request for an item based on the selected procurement option is additionally to deliver the item as specified by the shipping instructions?
 - that each of the procurement options is predefined for the user so as to "include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source", or each has a "distinct combination" of multiple types of information that is "sufficient to complete an order" for the identified item?

- that in addition to displaying indications of the multiple predefined procurement options to the user for use in ordering an item, also displaying an additional user-selectable indication to allow the user to interactively create a new procurement option that will be used to order the item?
 - that indications for the multiple predefined procurement options are displayed to the user so that the user can order an item using the item ordering information from one of the procurement options by merely selecting the displayed indication for that procurement option?
- C. Does the application as filed describe that the multiple procurement options for a user can each have “a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source” or “a unique combination of delivery and payment information” so as to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph?

VIII. GROUPING OF CLAIMS

Group 1: Claim 9 stands or falls alone. This claim is generally directed to a computing system assisting a user in ordering an item using one of multiple groups of order fulfillment information that are predefined for the user, with each order fulfillment information group having an associated combination of information that includes a payment source, delivery address, and shipping instructions. In particular, after the user selects a displayed control, indications of each of the multiple predefined groups are displayed, and after the user selects the displayed indication for one of the predefined groups, the item is then ordered using the associated information for that selected group without further intervention by the user.

Group 2: Claims 1-8 stand or fall together. In addition to being generally directed to the elements indicated above for the claim in Group 1, these claims are further directed to each of the predefined order fulfillment information groups for the user each having a unique combination of a payment source, a delivery address, and distinct shipping instructions.

Group 3: Claims 10, 14-17, 19-27 and 129 stand or fall together. These claims are generally directed to a computing system assisting a user in ordering an item using one of multiple procurement options that are predefined for the user, with each procurement option having an associated distinct combination of information of multiple types that includes at least payment information and delivery information and that is sufficient to complete an order for the item. In

particular, indications of each of the multiple predefined procurement options are displayed to represent ordering the item using the information for that procurement option, and the item is ordered using the associated information for one of the procurement options when it is selected.

Group 4: Claim 18 stands or falls alone. In addition to being generally directed to the elements indicated above for the claims in Group 3, this claim is further directed to assisting the user in creating and using new procurement options by displaying an indication representing a new procurement option, gathering at least some of the associated information for the new procurement option after the displayed indication is selected, creating the new procurement option using the gathered information, and using the gathered information for the new procurement option to order the item.

Group 5: Claim 13 stands or falls alone. In addition to being generally directed to the elements indicated above for the claims in Group 3, this claim is further directed to the selected procurement option further having associated shipping instructions that are to be used when delivering the ordered item.

Group 6: Claims 33, 36 and 38 stand or fall together. These claims are generally directed to a computing system assisting a user in ordering an item using one of multiple defined procurement options that are associated with the user, with each procurement option having an associated distinct combination of information of multiple types that includes a manner of delivering the item and of paying for the item and that is sufficient to complete an order for the item. In particular, indications of each of the multiple predefined procurement options are sent to a client system of the user, and after receiving an indication from the client system that one of the procurement options was selected to order the item, the associated information for the selected procurement option is retrieved and used to order the item.

Group 7: Claim 37 stands or falls alone. In addition to being generally directed to the elements indicated above for the claims in Group 6, this claim is further directed to creating and using a new procurement option for the user after that selection is made and at least some of the associated information for the new procurement option is received.

Group 8: Claim 35 stands or falls alone. In addition to being generally directed to the elements indicated above for the claims in Group 6, this claim is further directed to the

selected procurement option further having associated shipping instructions that are to be used when delivering the ordered item.

Group 9: Claims 67 and 68 stand or fall together. These claims are generally directed to the elements indicated above for the claims in Group 3, and further are directed to displaying the indications for multiple procurement options in response to an indication from the user, but do not recite that each of those defined procurement options includes an associated distinct combination of information of multiple types that is sufficient to complete an order for the item and that includes at least payment information and delivery information.

Group 10: Claims 64 and 65 stand or fall together. These claims are generally directed to the elements indicated above for the claims in Group 3, and further are directed to the client system of the user performing the ordering the item in response to the user's selection of the displayed indication for one of the multiple procurement options and without further intervention by the user, but do not recite that each of those defined procurement options includes a distinct combination of information of multiple types that is sufficient to complete an order for the item and that includes at least payment information and delivery information.

Group 11: Claims 31-32 stand or fall together. These claims are generally directed to the elements indicated above for the claims in Group 3, including reciting that each of the multiple procurement options includes information sufficient to complete an order for the item that includes at least payment information and delivery information, but do not recite that each of those defined procurement options includes a distinct combination of information.

Group 12: Claims 29-30 stand or fall together. These claims are generally directed to the elements indicated above for the claims in Group 3, including reciting that each of the multiple procurement options includes at least delivery information and payment information, but do not recite that each of those defined procurement options includes a distinct combination of information that is sufficient to complete an order for the item.

Group 13: Claims 40 and 41 stand or fall together. These claims are generally directed to the elements indicated above for the claims in Group 6, including reciting that each of the multiple procurement options includes information for completing an order for the item that includes at least payment information and delivery information, and further reciting that the server system performs the ordering the item without further intervention by the client system after

receiving an indication from the client system of the selection of one of the multiple procurement options, but do not recite that each of those defined procurement options includes a distinct combination of information.

Group 14: Claims 50 and 53-55 stand or fall together. These claims are generally directed to a data structure stored on a computer-readable medium, with the data structure storing indications of multiple procurement options similar to those indicated above for the claims in Group 3, including reciting that each of the multiple predefined procurement options includes an associated distinct combination of information sufficient to complete an order for an item that includes at least payment source information and delivery information, but do not explicitly recite that indications of each of the multiple predefined procurement options are displayed to the user.

Group 15: Claim 52 stands or falls alone. In addition to being generally directed to the elements indicated above for the claims in Group 14, this claim is further directed to each of the predefined procurement options having a unique combination of delivery and payment information for the single user with which they are associated.

Group 16: Claim 51 stands or falls alone. In addition to being generally directed to the elements indicated above for the claims in Group 14, this claim is further directed to each of the predefined procurement options further having associated shipping instructions for use when ordering the item.

Group 17: Claims 56-58 stand or fall together. These claims are generally directed to a device displaying a visual representation of a data structure stored in memory, with the visual representation including indications of one or more user-selectable controls that each represent one of multiple procurement options similar to those indicated above for the claims in Group 3, including reciting that each of the multiple procurement options includes a sufficient combination of information to complete an order for an item including at least payment source information and delivery information.

Group 18: Claims 59-63 stand or fall together. These claims are generally directed to a data structure stored on a computer-readable medium, with the data structure storing information that when displayed provides a visual representation of multiple procurement options similar to that indicated above for the claims in Group 17.

Please note that these groupings of claims have been made solely for the basis of this appeal, and are not intended to be relied upon for any other purpose, including in any litigation on a patent resulting from this patent application. Appellants' believe that many or all of the pending claims are patentable over the prior art of record for a variety of additional reasons that are not discussed in this Appeal Brief in order to simplify the issues on appeal.

IX. ARGUMENTS

A. **None Of The Cited References Teaches Or Suggests Using Multiple Predefined Procurement Options To Assist A User In Ordering An Item, With Each Procurement Option Having Associated Information Of Multiple Types Including At Least Payment Information And Delivery Information.**

Each of the appealed claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-63 and 129 (the claims of Groups 1-8 and 11-18) contains elements that recite using multiple predefined procurement options to assist a user in ordering an item, with each procurement option having associated information of multiple types that include at least payment information and delivery information. For example, independent claims 1, 10 and 29 recite the following:

claim 1

1. A method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information, the method comprising:

displaying at the client system information identifying the item;

displaying at the client system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source;

when the displayed element is selected by the user, displaying at the client system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group,

so that a single action of selecting a group of order fulfillment information orders and pays for the item.

claim 10

for each of multiple procurement options defined for that user that each have a distinct combination of information that is sufficient to complete an order for the identified item, the combination of information for each defined procurement option including multiple types of information that include at least payment information and delivery information, displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication such that the payment information for that procurement option will be used to pay for the identified item and such that the delivery information for that procurement option will be used for delivery of the identified item.

claim 29

for each of multiple procurement options that each have information related to ordering that includes at least delivery information and information regarding payment, displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

Each of the claims on appeal other than the claims of Groups 9 and 10 contains similar language, including independent claims 9, 31, 32, 33, 40, 41, 50, 56 and 59.

However, none of the cited references teaches or suggests the existence of multiple defined procurement options or defined order fulfillment information groups for use by a user in ordering items that each include multiple types of information, let alone a combination of at least payment information and delivery information. Therefore, the Examiner has failed to establish even a *prima facie* case of obviousness for these claims. To meet the burden of establishing a *prima facie* case of obviousness, “the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles.” *Ex parte Kranz*, 19 U.S.P.Q.2d 1216, 1218 (Bd. Pat. App. & Interf. 1991). Furthermore, “[t]he mere fact that the prior art may be modified in the manner suggested by the

Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added). To show a suggestion, the Examiner must show that “the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993).

In particular, the rejection of each of claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-63 and 129 fails to achieve even a *prima facie* case of obviousness because none of the references used to reject these claims mentions or suggests the idea of having multiple predefined groups of ordering information for a user for any purpose, let alone multiple predefined procurement options that significantly expedite the ordering process of items by each containing sufficient information for use as an alternative in ordering an item for the user or for a gift recipient. In particular, Yamada includes only the idea of having multiple predefined delivery addresses for a user, and the Examiner concedes that “Hartman did not disclose displaying multiple groups/procurement options having information related to ordering the identified item.” Even if the Examiner had established a motivation to combine the techniques from Hartman and Yamada, the resulting combination would not have multiple predefined procurement options that each have sufficient information to complete an order for an item so as to enable the ordering of an item merely by selecting any of the predefined procurement options, and in particular would not have multiple predefined procurement options that each have associated information of multiple types including at least payment information and delivery information, as recited. Instead, a combination of Hartman and Yamada would result in a system in which a user can use a single previously provided delivery address and financial information to order an item with a single action, and in which a user can select among multiple predefined delivery addresses when ordering items from a shopping cart. As with other shopping systems using shopping carts, the user would also presumably need to manually specify payment information after selecting one of the predefined delivery addresses, as discussed in Hartman. Thus, a combination of Hartman and Yamada would not result in multiple predefined procurement options that each have associated payment information and delivery information, and the Examiner has provided no explanation, motivation or suggestion how such a Hartman/Yamada combination system would be able to operate in the claimed manner. Moreover, the other cited references, including Holland and Gatto, do not

appear to remedy this failing in the combination of Hartman and Yamada, as they appear to be unrelated to using predefined groups of information of multiple types in the manner recited.

Thus, while Appellants' do not fully understand the Examiner's rejection, it appears to be based on a fundamental misunderstanding of Yamada. In particular, the Examiner has asserted multiple times that "Yamada teaches displaying multiple groups/procurement options having information related to ordering the item", and appears to be relying on the existence of such "groups/procurement options" in Yamada as the basis for the idea of having multiple procurement options for use in ordering items. (Examiner's Action dated July 8, 2003, 3:3-5, 10:2-4, and 3:7-11.) However, as discussed above, Yamada discloses only having multiple defined delivery addresses for the user. Appellants can only conclude that the Examiner mistakenly believes that each delivery address is itself a "group/procurement option", perhaps based on the fact that a delivery address typically contains various information (*e.g.*, a street name, an address number on that street, a city name, etc.). However, it is clear from the appealed claims and Appellants' application that a delivery address is treated by Appellants as a single unit of information for the purpose of having a procurement option with multiple types of information. More importantly, the Examiner has provided no basis for how the delivery address "groups/procurement options" of Yamada do or could contain financial payment information for items being ordered, as is explicitly recited by these claims.

Thus, the Examiner has failed to provide any explanation of how the asserted combination of Hartman and Yamada would even be operable to performed the recited functionality, let alone where the motivation or suggestion exists to transform each of the multiple predefined delivery addresses of Yamada into a distinct procurement option that includes multiple types of information, including at least payment information. As the only motivation to modify a combination Hartman/Yamada system to include the inventive predefined procurement options appears to be based on hindsight reconstruction using Appellants' disclosure, the Examiner has failed to provide even a *prima facie* case of obviousness. Thus, claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-63 and 129 are each patentable over the cited prior art for at least this reason.

In addition, even if the Examiner had succeeded in establishing a *prima facie* case of obviousness, the Examiner has failed to establish that the claims are obvious in light of the combination of the references. The touchstone of an obviousness determination is a comparison

of the differences between the claimed invention and the cited references. *Graham v. Deere*, 383 U.S. 1, 17 (1966). If those differences would not be obvious to a person of ordinary skill in the art, then the applicant is entitled to a patent. *Id.*

In particular, even if the Examiner had provided the motivation to transform Yamada's delivery addresses into the recited multiple procurement options that each can include payment and other types of information, the Examiner would still have failed to provide any motivation or suggestion for using such defined procurement options in the manner recited. In particular, the Examiner has provided no motivation or suggestion for displaying indications of each of the predefined procurement options to the user in such a manner that the ordering process for an item can be initiated, and in some embodiments completed, with a single selection by the user of one of the predefined procurement options. In contrast, and as noted above, a combination of Hartman and Yamada would result in a system in which a user can select to use a single previously provided delivery address and financial information to order an item with a single action, or in which a user can select among multiple predefined delivery addresses when ordering items from a shopping cart, such as by also manually specifying payment information to be used after selecting one of the predefined delivery addresses. The Examiner has provided no motivation or suggestion why one skilled in the art would consider it obvious to modify such a combination Hartman/Yamada system to display user-selectable indications of each of the multiple procurement options to the user so that the user can efficiently initiate the ordering process for an item by selecting the displayed indication of the group of order fulfillment information to be used in ordering the item.

Thus, not only would a combination of Hartman and Yamada not result in multiple predefined procurement options that each have associated payment information and delivery information, but it would also not be obvious to one skilled in the art based on Hartman and Yamada to use displayed user-selectable indications of multiple procurement options in the manner recited in the claims. For these reasons as well, the Examiner's rejection of claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-63 and 129 is improper, and the claims are patentable over the cited prior art.

B. In Addition To Failing To Teach Or Suggest The Use Of Multiple Predefined Procurement Options That Each Have Associated Information Of Multiple Types, None Of The Cited References Teaches Or Suggests Each Of Several Additional Recited Claim Elements.

The appealed claims further recite numerous additional claim elements that the Examiner has failed to even mention in his rejection of the appealed claims, as discussed in greater detail below. As the cited references fail to teach or suggest any of these additional claim elements, the claims reciting those claim elements are patentable over the cited prior art for each of these reasons as well.

1. None Of The Cited References Teaches Or Suggests That The Predefined Procurement Options Include “Shipping Instructions” For Use In Delivering Ordered Items In Addition To The Delivery And Payment Information.

Each of the appealed claims 1-9, 13, 35 and 51 (the claims of Groups 1, 2, 5, 8 and 16) contains elements that recite that at least the predefined procurement option selected to order the item further includes shipping instructions in addition to the delivery and payment information. For example, claims 1 and 35 recite the following:

claim 1

1. A method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information, the method comprising:

displaying at the client system information identifying the item;

displaying at the client system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source;

when the displayed element is selected by the user, displaying at the client system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group,

so that a single action of selecting a group of order fulfillment information orders and pays for the item.

claim 35

The method of claim 33 wherein the information associated with the selected procurement option includes shipping instructions, and including using the shipping instructions to deliver the identified item [with claim 33 further reciting that the associated information for each procurement option is a “distinct combination of associated information that is sufficient to complete an order for the identified item” and that includes “at least payment information and delivery information for a specified recipient”].

Each of the other claims of Groups 1, 2, 5, 8 and 16 contains similar language.

However, none of the cited references teaches or suggests the use of shipping instructions with a predefined group of item order fulfillment information or predefined procurement option. Moreover, the Examiner has failed to even address this claim element, and thus has failed to establish even a *prima facie* case of obviousness for these claims. In particular, the Examiner’s full rejection of the dependent claims 13, 35 and 51 directed to this claim element is as follows:

Hartman/Yamada further teaches all the limitations cited in claims 2-7, 13, 15-27, 30, 35, 37, 38, 51-55, 57-58, 60-63, 65, and 129, (see Hartman, col. 2, line 51-col. 10, line 44, and Yamada, col. 1, line 19-col. 5, line 20).

Examiner’s Action dated July 8, 2003, 10:16-18.

Thus, the Examiner points to the entire Detailed Description and Summary sections of Hartman and Yamada for a group of 37 claims, including these 3 claims, without any further discussion or clarification. Similarly, with respect to independent claim 9, the Examiner generally asserted that Hartman showed all claim elements other than displaying multiple procurement options, citing all of Hartman other than the Background, claims and the last paragraph of the Detailed Description section. (Examiner’s Action dated July 8, 2003, 9:20-21.) The discussion of claims 1-7 did not address the prior art at all due to the Examiner’s written description rejection, and the discussion of dependent claim 8 was unrelated to this claim element. (Examiner’s Action dated July 8, 2003, 9:20-21, 7:12-8:4, 10:19-11:12.)

Thus, Appellants are not able to comment on the Examiner’s basis for rejection of this aspect of these claims, as the Examiner has failed to provide that basis other than with a general indication to the entire Hartman and Yamada references. Nonetheless, Appellants note that they

can find no discussion in any of the cited references of predefining shipping instructions for use with a procurement option or with a predefined order information fulfillment group. Instead, Hartman mentions the use of a delivery address (referred to as a “shipping address”) to which an ordered item will be delivered. While such item delivery will of course inherently occur using some type of shipping method, Appellants can find no mention of shipping instructions being predefined by a user for use with item ordering.

Moreover, even if Hartman did disclose having predefined shipping instructions for a user for use with single-action ordering, the Examiner has not provided any teaching, suggestion or motivation to transform Yamada’s multiple predefined delivery addresses into the recited multiple procurement options that each further include shipping instructions and payment information. For example, Appellants’ inventive system allows a user to define multiple procurement options that share a single delivery address and a single source of payment information, but that have differing sets of shipping instructions (*e.g.*, a first procurement option that specifies Next-Day Air shipping for use with perishable items and urgent items, and a second procurement option that specifies standard ground shipping for use with non-urgent items). The Examiner has provided no argument or explanation for how a combination Hartman/Yamada system could be transformed to provide such functionality, nor any suggestion or motivation to perform such a transformation.

Thus, for these reasons as well, the claims of Groups 1, 2, 5, 8 and 16 are patentable over the cited prior art.

2. None Of The Cited References Teaches Or Suggests That Each Of The Predefined Procurement Options Includes A “Unique Combination” Of A Delivery Address, Shipping Instructions, And A Payment Source Or Each Has A “Distinct Combination” Of Multiple Types Of Information That Is “Sufficient To Complete An Order” For An Identified Item.

The appealed claims 1-8 (the claims of Group 2) each recites that each of the multiple predefined order fulfillment information groups includes a “unique combination” of a delivery address, shipping instructions distinct from the delivery address, and a payment source. Similarly, each of the appealed claims 10-27, 33-38 and 129 (the claims of Groups 3-8) contains elements that recite that each of multiple procurement options predefined for a single user has a “distinct combination” of multiple types of information that is “sufficient to complete an order” for the identified item, and each of the appealed claims 50-55 (the claims of Groups 14-16) contains

elements that recite that each of multiple predefined procurement options has a “distinct combination” of multiple types of information that is “sufficient to complete an order” for the identified item. In particular, independent claims 1, 10, 33 and 50 recite the following:

claim 1

1. A method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information, the method comprising:

displaying at the client system information identifying the item;

displaying at the client system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source;

when the displayed element is selected by the user, displaying at the client system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group,

so that a single action of selecting a group of order fulfillment information orders and pays for the item.

claim 10

for each of multiple procurement options defined for that user that each have a distinct combination of information that is sufficient to complete an order for the identified item, the combination of information for each defined procurement option including multiple types of information that include at least payment information and delivery information . . . ;

claim 33

sending to the client system an indication of multiple procurement options that are all associated with a single user of the client system and that each have a distinct combination of associated information that is sufficient to complete an order for the identified item, the associated information for each procurement option stored on the server system and including at least payment information and delivery information for a specified recipient;

claim 50

multiple procurement options each having a distinct combination of information that is sufficient to complete an order for an item and that includes at least payment source information and delivery information . . .

However, as previously noted, none of the cited references teaches or suggests the use of multiple predefined procurement options at all, let alone multiple predefined procurement options for a single user that each have a “unique” or “distinct” combination of information of multiple types. While the multiple defined delivery addresses of Yamada may be distinct, the Examiner has provided no motivation or suggestion to transform such delivery addresses into distinct combinations of multiple types of information.

More generally, the Examiner has failed to even address this claim element, and thus has failed to establish even a *prima facie* case of obviousness for these claims. Instead, in a similar manner to that discussed in the prior section, when addressing these claims the Examiner has merely generally cited virtually all of the Hartman and Yamada references. (Examiner’s Action dated July 8, 2003, 9:8-10:15.) Thus, while Appellants are not able to comment on the Examiner’s basis for rejection of this aspect of these claims, Appellants note that they can find no discussion in any of the cited references of defining multiple unique or distinct combinations of information of multiple types for any purpose, let alone the multiple unique or distinct procurement options that are claimed.

Thus, for these reasons as well, the claims of Groups 2-8 and 14-16 are patentable over the cited prior art.

3. None Of The Cited References Teaches Or Suggests Displaying An Additional Indication To The User Along With The Displayed Indications Of The Multiple Predefined Procurement Options To Allow Interactive Creation Of A New Procurement Option For Use In Ordering The Item.

Appealed claim 18 (the claim of Group 4) generally recites displaying an indication to create a new procurement option for use in ordering the item, in addition to displaying information about an item that can be ordered by a user and displaying indications of each of multiple predefined procurement options for that user that can be used to order the item. In addition, claim 18 further recites creating the new procurement option based on provided information that includes delivery address information for the new procurement option, and

ordering the item using the new procurement option. In particular, claim 18 and the claims from which it depends recite the following:

claim 10

10. A method for assisting a user in ordering an item using a client system, the method comprising:

displaying information identifying the item;

for each of multiple procurement options defined for that user that each have a distinct combination of information that is sufficient to complete an order for the identified item, the combination of information for each defined procurement option including multiple types of information that include at least payment information and delivery information, displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication such that the payment information for that procurement option will be used to pay for the identified item and such that the delivery information for that procurement option will be used for delivery of the identified item.

claim 17

17. The method of claim 10 including:

displaying an indication representing a new procurement option such that selection of the displayed indication represents an ordering of the identified item using information of the new procurement option; and

after selection of the displayed indication representing the new procurement option, ordering the identified item by

receiving information identifying a delivery address for the new procurement option; and

sending to the server system a request to order the identified item such that the identified item is to be sent to the identified delivery address

claim 18

18. The method of claim 17 including creating the new procurement option with the identified delivery address as part of the new procurement option

However, as previously noted, none of the cited references teaches or suggests the use of multiple predefined procurement options for a user at all, let alone an ability for a user to dynamically create and use a new procurement option as part of the item ordering process.

While the Examiner has not provided an explicit rejection of claim 18 other than with the previously discussed general recitation that Hartman and Yamada describe the claim elements

recited in all of the dependent claims, Appellants believe that the Examiner may have intended another sentence in the prior Office Action to relate to this claim. Thus, Appellants will respond here as if the Examiner had rejected claim 18 on the basis of this additional sentence.

In particular, the Examiner asserted that “Hartman also teaches to create [sic, a] new procurement option for ordering the identified item (see at least Fig. 1B, “Review or change your 1-click orders”, col. 4, line 59-col. 5, line 8)” when discussing the independent claims, including independent claim 10. However, as the Examiner appears to mis-interpret that portion of Hartman, the cited passage is included below.

When the purchaser selects the single-action ordering button, the client system sends a message to the server system requesting that the displayed item be ordered. After the server system processes the message, the server system provides to the client system a new Web page that confirms receipt of the single-action order. FIG. 1B illustrates the display of a Web page confirming a single-action order. The confirming Web page contains essentially the same information as the Web page describing the item (i.e., FIG. 1A) except that an order confirmation section 105 is displayed at the top of the Web page. The order confirmation section confirms that the order has been placed and provides an opportunity for the purchaser to review and change the single-action order. Alternatively, the confirming Web page can be identical to the Web page describing the item (i.e., FIG. 1A), except that the single-action ordering button is replaced with a message confirming the order.

Hartman, 4:59-5:8 (emphasis added).

Thus, Hartman describes that, after an order for an item has been placed and sent to the server system, the server system provides the ability to the user at the client system to “review and change the single-action order.” While not disclosed by Hartman in the cited passage, it is thus possible that the user may be able to cancel an order or to change the delivery address to which an item will be sent. However, even under this liberal reading of the disclosure of the cited portion of Hartman, Appellants do not understand why the Examiner believes that changing an order that has previously been placed is equivalent to, or even related to, the creation of a new procurement option that will be used to place an initial order for an item. To the extent that the Examiner is arguing that it would be obvious to modify Hartman so that any additional information supplied by the user when changing a previously placed order could be captured and then later used when the user next performs single-action ordering, the Examiner has provided no basis for where the motivation or suggestion to make such a change would be found. Moreover, even if Hartman was modified so that such supplied information was used with the next single-action ordering, the

Examiner has provided no basis for any motivation or suggestion that the additional information could further be used to create a new procurement option that could later be used in conjunction with multiple other predefined procurement options for the user.

Thus, since the Examiner has failed to provide any explanation of how Hartman could be modified to be operable to perform the actions of the recited claim elements, and further has failed to provide any motivation or suggestion to perform any such modification of Hartman, the Examiner has thus failed to establish even a *prima facie* case of obviousness for claim 18. Thus, for these reasons as well, claim 18 of Group 4 is patentable over the cited prior art.

4. None Of The Cited References Teaches Or Suggests That The User Can Order An Item Using The Item Ordering Information Associated With One Of Multiple Predefined Procurement Options By Merely Selecting The Displayed Indication For That Procurement Option.

Each of the appealed claims 1-9 (the claims of Groups 1 and 2) recites that indications of each of the multiple predefined order fulfillment information groups for a user are displayed in response to selection by the user of a displayed element “representing order fulfillment instructions” for the displayed item, and that an order request using the information for one of the predefined information groups is sent to the server system in response to selection of the displayed indication for that information group. Similarly, each of the appealed claims 64-65 and 67-68 (the claims of Groups 9 and 10) contains elements that recite that indications of each of the multiple procurement options are displayed and that an order request to use a procurement option is sent to the server system in response to selection of the displayed indication for that procurement option, and each of the appealed claims 1-9, 33, 35-38, 40-41, and 64-65 (the claims of Groups 1-2, 6-8 and 10) recite that an order request to use a procurement option is performed without further intervention. In particular, independent claims 1, 40, 64 and 67 recite the following:

claim 1

1. A method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information, the method comprising:

displaying at the client system information identifying the item;

displaying at the client system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source;

when the displayed element is selected by the user, displaying at the client system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group,

so that a single action of selecting a group of order fulfillment information orders and pays for the item.

claim 40

after receiving an indication from the client system to order the identified item using a selected one of the multiple procurement options and without further intervention by the client system, requesting delivery of the identified item to a recipient specified by the selected procurement option, the delivering in a manner specified by the selected procurement option.

claim 64

for each of multiple procurement options having information related to ordering, displaying an indication of the procurement option such that selection of the displayed indication represents an ordering of the identified item using the information of the procurement option; and

in response to selection of a displayed indication by a user and without further intervention by the user, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

claim 67

in response to an indication received from the user, displaying an indication for each of multiple procurement options associated with the user that have information related to ordering the identified item, the displayed indications such that selection of one of the displayed indications represents an instruction to order the identified item using the information of the procurement option associated with the selected indication; and

in response to selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option associated with the selected indication.

Each of the other claims of Groups 1-2 and 6-10 contains similar language.

However, none of the cited references teaches or suggests the displaying of indications of multiple predefined order fulfillment information groups to a user in response to a user selection of a displayed element representing ordering instructions for the current item or the ordering of an item using the information of a procurement option in response to the selection of its displayed indication. Moreover, the Examiner has failed to even address these claim elements, and thus has failed to establish even a *prima facie* case of obviousness for these claims. In particular, the Examiner makes no mention of the prior art providing a suggestion or motivation of the former claim recitation, and addresses the latter claim recitation only by generally asserting that Hartman discloses single-action ordering after selection of a displayed indication. (Examiner's Action dated July 8, 2003, 9:16-21.)

With respect to displaying to a user indications of the multiple predefined order fulfillment information groups in response to user selection of an ordering instructions element for the current item, Appellants can find nothing even remotely similar in the cited prior art, and are unable to comment further on the Examiner's basis for rejection of this aspect of these claims due to the failure to address them. Thus, claims 1-9 are patentable over the prior art for at least these reasons.

With respect to displaying indications of each of the predefined procurement options and ordering an item using the information of one of the multiple predefined procurement options in response to the selection of its displayed indication, Appellants can similarly find no teaching or suggestion in the prior art to even display such indications, let alone to perform the ordering of the item "in response" to selection of one of the displayed indications. Moreover, some of the appealed claims further clarify that the ordering is performed "without further intervention" after such selection of one of the multiple displayed procurement options, including claims 1-9, 33, 35-38, 40-41, and 64-65 (the claims of Groups 1-2, 6-8 and 10). While it is true that a user selects one of the predefined delivery addresses in Yamada during the middle of the ordering process (in a manner similar to that of a shopping cart model checkout), such selection does not cause the ordering of the item to be performed "in response," and certainly not "without further intervention." Similarly, while a user can initiate single-action ordering of an item in Hartman by selecting a displayed ordering button, such a selection is not of one of multiple displayed indications of the predefined procurement options for a user. The Examiner has provided no

motivation or suggestion in the prior art to modify Hartman and/or Yamada in such a way as to display multiple user-selectable indications of procurement options to the user so that an item order request can be generated in response to selection of one of the displayed procurement options.

Thus, for these reasons as well, the claims of Groups 1-2 and 6-10 are patentable over the cited prior art.

C. Appellants' Application As Filed Describes That Multiple Predefined Order Fulfillment Information Groups Can Each Have "A Unique Combination Of A Delivery Address, Shipping Instructions Distinct From The Delivery Address, And A Payment Source" And That Multiple Procurement Options Can Each Have "A Unique Combination Of Delivery And Payment Information."

Appealed claims 1-8 (the claims of Group 2) each recite that each of the multiple predefined order fulfillment information groups includes a "unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source," and appealed claim 52 (the claim of Group 15) similarly recites that "each of the procurement options is a unique combination of delivery and payment information." The Examiner has rejected each of these claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement based on these recitations (Examiner's Action dated July 8, 2003, 7:11-8:18 and 5:1-14) – this rejection is the sole basis of rejection for claims 1-7 and 52.

However, it is clear from the application as filed that Appellants had possession at the time of filing of the application that different procurement options and order fulfillment information groups could have unique combinations of information, and thus the Examiner's rejection of these claims is improper. In particular, the first paragraph of 35 U.S.C. § 112 specifies that the specification shall contain a "written description" of the invention so as to "reasonably convey to the artisan [one skilled in the art] that the inventor had possession" at the time of application filing of the claimed subject matter. *Studiengesellschaft Kohle, m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 U.S.P.Q.2d 1674 (Fed. Cir. 1997). The specification "need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed." *All Dental Prodx LLC v. Advantage Dental Prods.*, 309 F.3d 774, 64 U.S.P.Q.2d 1945 (Fed. Cir. 2002)

(citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991)). For example, the court in *All Dental* found that, while the application at issue “as originally filed did not contain the phrase ‘original unidentified mass’; indeed, there is no mention of the starting material’s shape or form anywhere in the patent specification,” the application nonetheless satisfied the written description requirement because “one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” *Id.*

Appellants’ application as filed makes clear that predefined procurement options and order fulfillment information groups can include various combinations of information in different embodiments, including delivery and payment information in some embodiments, and further including shipping instructions in other embodiments. Moreover, Appellants’ application as filed makes clear that in some embodiments each procurement option or order fulfillment information group for a user can include a “unique combination” of information. In particular, Appellants’ application as filed recites the following:

In some embodiments, multi-procurement option ordering of an item is provided in which multiple alternatives for completing the ordering of the item are available. In particular, each user can have multiple defined procurement options . . . Each procurement option can have a unique set of purchaser-specific order information (e.g., payment information, delivery address, delivery instructions, shipping instructions, wrapping instructions, etc.) . . .

Appellants’ application as filed, 25:3-15 (emphasis added).

each procurement option may have a unique set of information for completing the order of the item. . . . For example, [while] procurement options 2007 and 2008 each . . . have the same recipient and the same delivery address, those two procurement options may vary in other ways, such as by payment information . . . or by shipping instructions . . .

Appellants’ application as filed, 28:24-29:2 (emphasis added).

In some embodiments, a user can perform the ordering of an item by specifying a new procurement option. . . . After selecting one of the options, the user is prompted to supply enough information to allow the system to purchase and deliver the item. After supplying the information, the order will be completed in accordance with the newly created procurement option, as described in greater detail with respect to Figures 21A-C and 22. . . . Figures 21A-21C illustrate an embodiment of adding an additional customer procurement option. . . . The procurement option information to be added

includes delivery address information 2104, phone number contact information 2105, payment information 2106, shipping instructions 2107, and moniker information 2108.

[T]hose skilled in the art will appreciate that a subset of the information requested for new customer and recipient procurement options may be sufficient for the procurement option to be used to complete the order of an item.

the user has selected to create a new procurement option that is to be used to order the item. If so, the client and server systems attempt to collect sufficient information from the user in order to create a procurement option that is enabled for ordering. When sufficient information has been received, the new procurement option is added to the customer information group for the user in the customer database, and the information for the new procurement option is used to complete the ordering of the item.

Appellants' application as filed, 30:2-31:29, 33:7-10, 35:28-36:4 (emphasis added).

Appellants believe that statements such as those above would not only reasonably convey to one skilled in the art that the idea of different procurement options for a user having different unique combinations of information was in the possession of Appellants at the time of application filing, but would make abundantly clear that Appellants possessed the idea of having unique combinations of delivery address and payment information and of having unique combinations of delivery address, payment information and shipping instructions.

Moreover, numerous additional examples throughout the application as filed further describe the use of procurement options with unique combinations of information. For example, Appellants' application as filed further illustrate an example address book in Figures 32A and 32B that "in the illustrated embodiment . . . is used to generate the list of procurement options displayed in Figure 31B." (Appellants' application as filed, 49:8-11.) The application as filed further indicates that each of the address book entries "includes a variety of delivery, payment and shipping information," with Figures 32A and 32B illustrating that each of the entries has a unique delivery address. Since each delivery address is unique in this example embodiment, each combination of delivery address and payment information is also necessarily unique, as is each combination of delivery address, payment information and shipping instructions.

In addition, various other statements in Appellants' application as filed further clarify that procurement options can be created for a user and displayed to the user even if those procurement options lack information that is stored for procurement options in a particular embodiment, as shown below – thus, even if a particular embodiment by default includes information beyond payment information, a delivery address and shipping instructions for procurement options (e.g., to also include delivery instructions and wrapping instructions), some or all of the procurement

options in such embodiments could include, for example, only a delivery address and payment information. Thus, such statements further clarify that it was in Appellants' possession that each procurement option for a user could have various combinations of information.

In some embodiments, a procurement option will be displayed only if it is currently enabled and thus available to complete an order for the item. . . . Procurement options can be non-enabled for a variety of reasons, such as due to a lack of sufficient information necessary to complete the ordering of the item (*e.g.*, payment information or a delivery address) . . . Even if sufficient information to complete an order cannot be currently identified, a partially specified procurement option can be created and added to the customer database [on the server]. . . . the server system may supply some or all of the procurement option information for the various possible procurement options to the client system and the client system will determine which of the options are currently enabled. . . . [I]n various embodiments different groups of procurement options are displayed [by the client], such as only enabled procurement options, only customer procurement options, all procurement options for the user, all procurement options for one or more customers that are possible identities of the current user, etc.

Appellants' application as filed, 29:13-21, 34:28-35:15, 38:4-39:7.

Thus, since Appellants' application as filed far exceeds a 'reasonable conveyance' of Appellants' possession of the ideas that each procurement option for a user has a "unique combination of delivery and payment information" and that each predefined order fulfillment information group for a user has a "unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source," the Examiner's rejections of claims 1-8 and 52 under 35 U.S.C. § 112, first paragraph, is clearly improper. Thus, for these reasons as well, claims 1-8 and 52 are patentable.

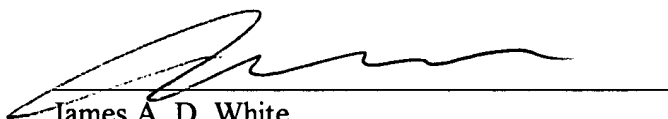
X. SUMMARY

Claims 8-10, 13-27, 29-33, 35-38, 40-41, 50-51, 53-65, 67-68 and 129 have each been improperly rejected over the Hartman and Yamada references, either alone or in combination with the Holland reference, and claims 1-8 and 52 have each been improperly rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner fails to provide even a *prima facie* case of obviousness for claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-63 and 129 by providing no suggestion or motivation to transform a Hartman/Yamada combination system to include multiple predefined procurement options for a user that each include at least delivery information and payment information. Moreover, the

Examiner fails to provide any motivation or suggestion to modify the cited prior art references to perform various additional recited claim elements of many of the rejected claims, failing to even mention many of these additional recited claim elements. Finally, the Examiner fails to justify that claims 1-8 and 52 have each been properly rejected under 35 U.S.C. § 112, first paragraph.

Accordingly, Appellants respectfully request that the Board reverse the rejection of each of the appealed claims.

Respectfully submitted,
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JDW:

Enclosures:

Postcard
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Appeal Brief Transmittal
Two copies of this Brief
Appendix

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APPENDIX

1. (Previously Presented) A method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information, the method comprising:

displaying at the client system information identifying the item;

displaying at the client system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source;

when the displayed element is selected by the user, displaying at the client system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group,

so that a single action of selecting a group of order fulfillment information orders and pays for the item.

2. (Original) The method of claim 1 wherein the selection by the user of the displayed element includes clicking a mouse button when a cursor is positioned over the displayed element, and wherein the selection by the user of the displayed indication of the one identified group includes positioning the cursor over the displayed indication.

3. (Original) The method of claim 1 including displaying at the client system an indication to add the identified item to a collection of items for later ordering.

4. (Original) The method of claim 1 including:
displaying at the client system an indication representing other order fulfillment information; and

after selection by the user of the displayed indication representing other order fulfillment information, ordering the identified item by

receiving information identifying a delivery address; and

without further user intervention, sending to the server computer a request to order the identified item such that the identified item is to be sent to the identified delivery address.

5. (Original) The method of claim 4 wherein the identified delivery address is for a recipient other than the user, and including receiving a name of the recipient and storing the name and identified delivery address as part of a new group of order fulfillment information.

6. (Original) The method of claim 4 wherein the received information identifying the delivery address is information indicating an identity other than the user, and including retrieving address information for the identity to be used as the identified delivery address.

7. (Original) The method of claim 4 including receiving payment source information from the user prior to the selection by the user of the displayed indication representing other order fulfillment information, and wherein the sent request to order the identified item specifies that the item is to be paid for by the received payment source.

8. (Original) The method of claim 1 wherein the displayed element further represents a displayed indication of a default one of the identified multiple groups, and including:

receiving an indication of a single action by the user that selects the displayed indication of the default group; and

without displaying an indication of each of the identified multiple groups, performing the sending of the request to the server computer.

9. (Previously Presented) A computer-readable medium whose contents cause a computer system to place an order for an item from a user, the user having a plurality of groups of predefined order fulfillment information, by:

displaying at the computer system information identifying the item;

displaying at the computer system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of predefined order fulfillment information each including a delivery address, shipping instructions, and a payment source;

when the displayed element is selected by the user, displaying at the computer system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group.

10. (Previously Presented) A method for assisting a user in ordering an item using a client system, the method comprising:

displaying information identifying the item;

for each of multiple procurement options defined for that user that each have a distinct combination of information that is sufficient to complete an order for the identified item, the combination of information for each defined procurement option including multiple types of information that include at least payment information and delivery information, displaying an indication of the procurement option such that

selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication such that the payment information for that procurement option will be used to pay for the identified item and such that the delivery information for that procurement option will be used for delivery of the identified item.

11-12. (Canceled.)

13. (Previously Presented) The method of claim 10 wherein the delivery information of the procurement option for the selected indication includes shipping instructions, and wherein the sent request is additionally to deliver the identified item as specified by the shipping instructions.

14. (Original) The method of claim 10 wherein the procurement option for the selected indication includes wrapping instructions for the item, and wherein the sent request is additionally to wrap the identified item as specified by the wrapping instructions.

15. (Original) The method of claim 10 wherein the selection of the displayed indication includes clicking a mouse button when a cursor is positioned over the displayed indication.

16. (Original) The method of claim 10 including displaying an indication to add the identified item to a collection of items for later ordering.

17. (Original) The method of claim 10 including:

displaying an indication representing a new procurement option such that selection of the displayed indication represents an ordering of the identified item using information of the new procurement option; and

after selection of the displayed indication representing the new procurement option, ordering the identified item by

receiving information identifying a delivery address for the new procurement option; and

sending to the server system a request to order the identified item such that the identified item is to be sent to the identified delivery address.

18. (Original) The method of claim 17 including creating the new procurement option with the identified delivery address as part of the new procurement option.

19. (Original) The method of claim 17 wherein the received information identifying the delivery address is information indicating an identity other than a user performing the selection of the displayed indication representing the new procurement option, and including retrieving address information for the identity to be used as the identified delivery address.

20. (Original) The method of claim 19 wherein the received information is an electronic mail address for the identity.

21. (Original) The method of claim 17 including receiving payment information prior to the selection of the displayed indication representing the new procurement option, and wherein the sent request to order the identified item specifies that the item is to be paid for by the received payment information.

22. (Original) The method of claim 10 wherein after the selection of the displayed indication of the procurement option, the sending of the request is performed without further intervention of a user who performs the selection.

23. (Original) The method of claim 10 wherein the information about the multiple procurement options is received from the server system.

24. (Original) The method of claim 10 wherein each displayed indication of a procurement option includes partial shipping information of the procurement option supplied by the server system.

25. (Original) The method of claim 10 wherein each displayed indication of a procurement option includes partial payment information of the procurement option supplied by the server system.

26. (Original) The method of claim 10 wherein each displayed indication of a procurement option includes a moniker identifying the procurement option.

27. (Original) The method of claim 10 wherein the client system stores an identification to be provided to the server system to identify a user of the client system so that the user does not need to enter identification information when ordering the identified item.

28. (Canceled.)

29. (Previously Presented) A computer-readable medium whose contents cause a computer system to order an item using a client system, by performing a method comprising:

displaying information identifying the item;

for each of multiple procurement options that each have information related to ordering that includes at least delivery information and information regarding payment, displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

30. (Previously Presented) The computer-readable medium of claim 29 wherein the computer-readable medium is a data transmission medium transmitting a generated data signal containing the contents.

31. (Previously Presented) A client system for ordering an item comprising:

a display component able to display information identifying the item and able to display, for each of multiple procurement options having information that includes at least payment information and delivery information and that is sufficient to complete an order for the identified item, an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

an item ordering component able to, after selection of a displayed indication, send to a server system a request to order the identified item using the information of the procurement option for the selected indication.

32. (Previously Presented) A client system for ordering an item comprising:

means for displaying information identifying the item and for displaying, for each of multiple procurement options having information that is sufficient to complete an order for the identified item and that includes at least payment information and delivery information, an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

means for, after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

33. (Previously Presented) A method for a server system to process an order for an item, the method comprising:

sending to a client system an indication of an item that may be ordered;

sending to the client system an indication of multiple procurement options that are all associated with a single user of the client system and that each have a distinct combination of associated information that is sufficient to complete an order for the identified item, the associated information for each procurement option stored on the server system and including at least payment information and delivery information for a specified recipient; and

after receiving an indication from the client system to order the identified item using a selected one of the multiple procurement options and without further intervention by the client system,

retrieving the stored associated information for the selected procurement option; and

requesting delivery of the identified item to the recipient specified by the selected procurement option, the delivering of and payment for the identified item in a manner specified by the selected procurement option.

34. (Canceled.)

35. (Previously Presented) The method of claim 33 wherein the information associated with the selected procurement option includes shipping instructions, and including using the shipping instructions to deliver the identified item.

36. (Previously Presented) The method of claim 33 wherein the information associated with the selected procurement option includes wrapping instructions for the item, and including using the wrapping instructions to wrap the identified item.

37. (Previously Presented) The method of claim 33 wherein a selected procurement option is an indication that a new procurement option is to be created and used, and including receiving delivery information for the new procurement option and creating the new procurement option to include the received delivery information.

38. (Previously Presented) The method of claim 33 including:
receiving an identifier from the client system; and
when the server system does not receive sufficient information from the client system to deliver the identified item to the recipient, retrieving previously supplied additional information associated with the identifier that is sufficient to deliver the identified item.

39. (Canceled).

40. (Previously Presented) A computer-readable medium whose contents cause a computer system to process an order for an item, by performing a method comprising:

sending to a client system an indication of an item that may be ordered;

sending to the client system an indication of multiple procurement options that each have associated information for completing an order for the identified item that includes at least payment information and delivery information; and

after receiving an indication from the client system to order the identified item using a selected one of the multiple procurement options and without further intervention by the client system, requesting delivery of the identified item to a recipient specified by the selected procurement option, the delivering in a manner specified by the selected procurement option.

41. (Previously Presented) A server system for processing an order for an item comprising:

a sending component able to send to a client system an indication of an item that may be ordered and able to send to the client system an indication of multiple procurement options each having associated information for completing an order for the identified item that includes at least payment information and delivery information for a recipient; and

a receiving component able to receive from the client system an indication that one of the multiple procurement options was selected and able to, after receiving an indication to order the identified item from the client system and without further intervention by the client system, deliver the identified item to a recipient specified by the selected procurement option in a manner specified by the selected procurement option.

42-49. (Canceled.)

50. (Previously Presented) A computer-readable medium containing a data structure for use in ordering an item, the data structure comprising:

a plurality of indications of multiple procurement options each having a distinct combination of information that is sufficient to complete an order for an item and that includes at least payment source information and delivery information, so that a user can perform a selection of the indication of one of the procurement options to indicate to use the information of the procurement option when ordering the item such that the payment source information for the procurement option will be used for payment and the delivery information for the procurement option will be used for delivery.

51. (Previously Presented) The computer-readable medium of claim 50 wherein each procurement option further includes shipping instructions.

52. (Previously Presented) The computer-readable medium of claim 50 wherein all of the procurement options are associated with a single user and wherein each of the procurement options is a unique combination of delivery and payment information for the user.

53. (Previously Presented) The computer-readable medium of claim 50 wherein the data structure includes an indication of the item.

54. (Previously Presented) The computer-readable medium of claim 50 wherein the computer-readable medium is a data transmission medium transmitting a generated data signal containing the data structure.

55. (Previously Presented) The computer-readable medium of claim 50 wherein the computer-readable medium is a memory of a computer system.

56. (Previously Presented) A display device for displaying a visual representation of a data structure stored in memory, the visual representation including an indication of an item to be ordered and at least one indication of a control that is selectable by a user, each control representing one of a plurality of multiple procurement options that each have sufficient information to complete an order for the item that includes at least payment source information and delivery information, so that a user can order the item using the information of a procurement option represented by a control after selecting the indication for the control such that the payment source information for the procurement option will be used for payment and the delivery information for the procurement option will be used for delivery.

57. (Previously Presented) The display device of claim 56 wherein the data structure represents a document for display.

58. (Previously Presented) The display device of claim 56 wherein the data structure represents a Web page.

59. (Previously Presented) A computer-readable medium containing a data structure having information for display, the information when displayed including an indication of an item to be ordered and at least one indication of a control that is selectable by a user, each control representing one of a plurality of multiple procurement options that each have sufficient information to complete an order for the item that includes at least payment source information and delivery information, so that a user can order the item using the information of a procurement option represented by a control after selecting the displayed indication for the control.

60. (Previously Presented) The computer-readable medium of claim 59 wherein the data structure represents a document for display.

61. (Previously Presented) The computer-readable medium of claim 59 wherein the data structure includes instructions for the display of the information.

62. (Previously Presented) The computer-readable medium of claim 59 wherein the computer-readable medium is a data transmission medium transmitting a generated data signal containing the data structure.

63. (Previously Presented) The computer-readable medium of claim 59 wherein the computer-readable medium is a memory of a computer system.

64. (Previously Presented) A method for ordering an item using a client system, the method comprising:

displaying information identifying the item;

for each of multiple procurement options having information related to ordering, displaying an indication of the procurement option such that selection of the displayed indication represents an ordering of the identified item using the information of the procurement option; and

in response to selection of a displayed indication by a user and without further intervention by the user, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

65. (Previously Presented) The method of claim 64 including displaying an indication to add the identified item to a collection of items for later ordering.

66. (Canceled.)

67. (Previously Presented) A computer-readable medium whose contents cause a computer system to assist a user in ordering an item, by:

displaying information identifying the item;

in response to an indication received from the user, displaying an indication for each of multiple procurement options associated with the user that have information related to ordering the identified item, the displayed indications such that selection of one of the displayed indications represents an instruction to order the identified item using the information of the procurement option associated with the selected indication; and

in response to selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option associated with the selected indication.

68. (Previously Presented) A computer system for assisting a user in ordering an item, comprising:

a display component capable of displaying information identifying the item and of, in response to an indication received from the user, displaying an indication for each of multiple procurement options associated with the user that have sufficient information to complete an order for the identified item, the displayed indications such that selection of one of the displayed indications represents an instruction to order the identified item using the information of the procurement option associated with the selected indication; and

an item ordering component capable of, in response to selection of a displayed indication and without further intervention, sending to a server system a request to order the identified item using the information of the procurement option associated with the selected indication.

69-128. (Canceled.)

129. (Previously Presented) The method of claim 27 including, before the displaying of the indications of the procurement options, providing the stored identification to the server system and receiving the indications from the server system in response.